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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/724,574

11/28/2003

Karl-Heinz Wendt

1085-029

8642

47888 7590 06/18/2007
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EXAMINER

CAMERON, ERMA C

ART UNIT

PAPER NUMBER

1762

MAIL DATE

DELIVERY MODE

06/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/724,574
Filing Date: November 28, 2003
Appellant(s): WENDT, KARL-HEINZ

MAILED
JUN 18 2007
GROUP 1700

Alan B. Clement
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/5/2007 appealing from the Office action mailed 3/31/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

- a) 35 USC 112, second paragraph rejection of claim 1.
- b) Claims 1, 3, 5, 8, 10-12, 16, 19-25 and 27 under 35 U.S.C. 103(a) as being unpatentable over EP 665252 taken in view of EP 428937.

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c) Claim 17 under 35 U.S.C. 103(a) as being unpatentable over EP 665252 taken in view of EP 428937 and further taken in view of Ellenson et al (2969328).

NEW GROUND(S) OF REJECTION

i) Claims 1, 3, 5, 8, 10-12, 16, 19-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 665252 taken in view of EP 428937 and further taken in view of Kirk-Othmer Encyclopedia of Chemical Technology, Fourth Edition, 1995, Volume 14, pages 498-499.

ii) Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 665252 taken in view of EP 428937 and further taken in view of Kirk-Othmer Encyclopedia of Chemical Technology, Fourth Edition, 1995, Volume 14, pages 498-499 and further taken in view of Ellenson et al (2969328).

(7) Claims Appendix

A substantially correct copy of appealed claims appears on page 16-19 of the Appendix to the appellant's brief. The minor errors are as follows: as applicant has correctly stated on page 2, claims 2, 4, 15 and 26 have been canceled in the advisory action filed 2/15/2007.

(8) Evidence Relied Upon

EP665252	Okamoto et al	8-1995
EP428937	Calahorra	5-1991

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Kirk-Othmer Encyclopedia of Chemical Technology, Fourth Edition, 1995, Volume 14, pages 498-499.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- a) Claims 1, 3, 5, 8, 10-12, 16, 19-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 665252 taken in view of EP 428937 and further taken in view of Kirk-Othmer Encyclopedia of Chemical Technology, Fourth Edition, 1995, Volume 14, pages 498-499.

'252 teaches a 2-pack coating composition for glass that comprises an acrylic polymer and a polyisocyanate with at least two isocyanate groups (2:21-54). The composition is a "paint, adhesive, ink, surface-treating agent and the like" (9:57-58). Solvents such as alcohols such as isopropanol or ester solvents may be present (9:31-47) at up to 40 wt%. There is present coloring or metallic pigments (10:1-5). The composition is applied by spraying, roller coating and other means, and the film thickness is 1-1000 microns, which overlaps with applicant's claimed thickness (10:6-10). After application to glass, the composition is cured, possibly at room temperature (10:1-13; 12:49-58).

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'252 teaches that the composition can be applied by "such means as, for example, spraying, roller-coating, brushing, dipping or the like" (10:1-10), but fails to specifically teach the use and then removal of a masking film in the application process.

Kirk-Othmer teaches that screen printing, using a screen stencil, is a conventional means of applying an ink, which is one of the purposes of the '252 composition, to glass. The screen stencil serves as a mask over the glass that is being coated, and will be removed after the application process is complete.

It would have been obvious to one of ordinary skill in the art to have used the screen printing technique taught by Kirk-Othmer in the '252 application process because of the teaching of Kirk-Othmer that screen printing, using a screen stencil (page 498 under "Screen Process Inks"), is a conventional way of applying ink to a glass surface (page 499, line 1).

'252 does not teach cleaning or priming the glass first, but it is conventional to at least clean a surface before applying another layer. It is also conventional to mask an area to be coated.

'252 teaches to apply the composition to glass in general, which would be inclusive of fire-resistant, composite or safety glass.

The surface tension would be inherent to the coating used.

'252 does not teach the particle size of the coloring or metallic pigments.

'937 teaches that the addition of reflective particles such as aluminum or TiO₂ in the 10-100 micron size provides good reflective properties for a transparent coating on a transparent substrate (2:1-6; 3:4-5).

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It would have been obvious to one of ordinary skill in the art to have used the reflective particles of 10-100 micron size as taught by '937 in the '252 process because of the teaching of '937 that such particles have good reflective properties in a transparent coating.

b) Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP 665252 taken in view of EP 428937 and further taken in view of Kirk-Othmer Encyclopedia of Chemical Technology, Fourth Edition, 1995, Volume 14, pages 498-499 and further taken in view of Ellenson et al (2969328).

'252 and '937 and Kirk-Othmer are applied here for the reasons given above.

None teaches that the coating would be removable with a halogen containing stripper.

'328 teaches that paints, resin and the like can be removed from glass and other surfaces, if so desired, with halogen containing solvents (1:152:56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have removed the coating of '252, as modified by '937, with the halogen containing composition of '328, if removal was desired.

(10) Response to Argument

The applicant has argued that '252 teaches a permanent although removable film on glass and that '937 teaches a temporary coating, and that therefore the two references are too remote to be properly combined together. The examiner disagrees. In the first place, it is the examiner's

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opinion that '252 removes the coating from the glass at 12:49-58 for testing purposes, not because it is anticipated that this would be the normal way the coating is treated. The examiner disagrees that '937 teaches exclusively a temporary coating. '937 teaches that the coating may remain in place (2:42-43). The examiner's position is that both coatings are for transparent substrates and may properly be combined.

The applicant has argued that '252 requires siloxane and therefore is chemically different from the claimed invention. The examiner's position is that '252 has the acrylate and isocyanate with two or more isocyanate groups, and therefore meets the limitations of claim 1.

The applicant has argued that the coating of the present invention is hard and nonflexible whereas the film of '252 can be elongated. However, these qualities are not in the claims.

The applicant has argued that '252 teaches coatings of 1 to 1000 um, but not in connection with glass, and that the example of application on glass is 200 um thick, thicker than the claimed 10 to 50 um of the claimed invention. It is the examiner's position that the example is merely illustrative, and that 1-1000 um coatings may be applied to any of the surfaces used by '252, including glass.

The applicant has argued that the average particle diameter of 0.01 to 1 um of the copolymer in '252 is another difference between '252 and the claimed invention. However, there are no claims as to particle size of the polymers in the claimed invention.

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Regarding applicant's arguments on the '937 reference, the '937 reference is used for an appropriate mineral particle size to be used on a transparent coating for good reflective properties.

Regarding applicant's remarks that '328 does not teach removal of isocyanate-cured polyacrylate lacquers or coatings with mineral particles, '328 teaches removing "paint, varnish, lacquer, baked resin bonds, enamel and the like from a wide variety of materials including...glass surfaces" (1:15-20), and goes on to say that their removal composition is effective with "acrylic,...indoor paints, outdoor paints, sealers, primers, lacquers, varnishes and baked enamels" (4:65-73), in other words, effective with a wide variety of resin-based coatings.

Regarding the unexpected results of pages 12-15:

Regarding improved light transmission – this does not appear in the claims.

Regarding improved disinfection – this does not appear in the claims, and the article the applicant has submitted to support this is in German, and no translation was supplied.

Regarding fire resistant glass – the only claim to specific glasses lists fire resistant glass as one of 3 claimed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

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Respectfully submitted,

Erma Cameron


A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

Erma Cameron


ERMA CAMERON
PRIMARY EXAMINER

Tim Meeks


TIMOTHY MEES
SUPERVISORY PATENT EXAMINER

Kathryn Gorgos

